

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of December 20, 2010 and respectfully requests reconsideration of the application.

I. § 101 and claim 28

Before amendment, claim 28 recited as follows:

28. A method comprising the steps of:
at a computer system, receiving ...
at the computer system, receiving ...;

The Action does not explain why “at a computer system” in the body of the claim does not satisfy the “machine or transformation” test; the Action appears to have overlooked the claim language that is most pertinent to the issue. Why is a “computer system” not a “machine” for *Bilski* purposes?

Paragraph 6 of the Action suggests that adding the word “computer” in the claim preamble might be relevant. That is not the law. In the early 1980’s, the CCPA considered two cases, both directed to computer processing of seismic data for oil prospecting. One claim recited a tangible feature in the preamble, the other had the operative language in the body of the claim. The court held that the preamble was not helpful, that it was the body of the claim that mattered. *Contrast In re Walter*, 618 F.2d 758, 767-70, 205 USPQ 397,409 (CCPA 1980) (claim not patentable where computer “signals” appears only in the preamble: “The specific end use recited in the *preambles* does not save the claims from the holding in *Flook*.”) *with In re Johnson*, 589 F.2d 1070,200 USPQ 199 (CCPA 1980) (a claim directed to essentially similar subject matter is patentable under § 101, because the “seismic trace” signal appears in the body of the claim). This remains true today: the Board often notes that a “computer” in the preamble is irrelevant to patentability under § 101,¹ it’s the claim body that matters.

The § 101 rejection of claim 28 should be withdrawn.

¹ *Ex parte Dettinger*, Appeal 2009-006998, <http://dcs.uspto.gov/Foia/RetrievePdf?system=BPAI&fNm=f2009006998-09-24-2010-1> at 8, 2010 WL 3768179 at *4 (BPAI Sept. 24, 2010) (“the recitation of a computer implemented method in the [preamble of claim 17] ... does not by itself impart any structural or hardware component to the recitations in the body ... no computer is recited in the body of these claims to perform the recited functions or steps,” and for that failure of the *body*, the claim fails *Bilski*).

II. Conclusion

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

A Petition for Extension of Time extends the shortened statutory period through June 20, 2011. Accordingly, this reply is timely. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

In view of these remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. For the entire pendency of this application, the Commissioner is hereby authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3938, Order No. 01-1040.

Respectfully submitted,
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